

REMARKS

1. **Rejection of Claims 1, 3, 6-12, 14-17, 19, 23-23, 25-38, and 41-46 under 35 U.S.C. § 103(a) as being unpatentable over LeRoy (patent number 5,970,474), in view of Robertson (patent number 6,609,106).**

Responsive to the rejection of Claims 1, 3, 6-12, 14-17, 19, 23-23, 25-38, and 41-46 under 35 U.S.C. § 103(a) as being unpatentable over LeRoy (U.S. Patent No. 5,970,474), in view of Robertson (U.S. Patent No. 6,609,106), the applicants submit that the combination of the cited references fails to disclose all aspects of the present invention.

LeRoy discloses a system which allows users to use a product selection device to choose items in a retail store. The items are then communicated to a registry database on host computer via a local area network. The registry database includes items that a user has selected using the product selection device. The invention also discloses a point of sale input device which identifies purchased items and updates the registry database to indicate which items have been purchased. The invention further discloses a system whereby registry databases at individual retail stores can be synchronized with a master registry database across a wide area network (internet).

Robertson discloses a system and method which allows users to create a gift registry which includes products from multiple on-line merchants. The selected items are then stored centrally in a database as elements of a wish list by sending information over the internet to a centralized Gift Registry site. Robertson also discloses a system whereby individuals can make purchases for a registrant using the wish list. The wish list items can be searched and organized by price or category. The patent also discloses that the purchase of all items in the wish list can be delayed to a certain specified date corresponding to a future time or event. Additionally, registrants of the system can receive an automatic notification upon the arrival of the specified time or event.

The Examiner must first make out a *prima facie* case for obviousness in order to initially reject claims under 35 U.S.C. § 103(a). Graham v. John Deere, 383 U.S. 1 (1966). The *prima facie* case of obviousness based upon combining references requires that each and every claim

limitation must be present in the combination. MPEP § 2143 ("First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations."). The justification to modify or combine the prior art may be expressly or impliedly contained in the prior art or "it may be reasoned from knowledge generally available to one of ordinary skill in the art, established scientific principles, or legal precedent established by prior case law". MPEP §2144. *See e.g., In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). If the Examiner fails to make out a *prima facie* case for obviousness, the rejections are invalid. MPEP §2142. Applicants submit that the combination of references cited by the Examiner (LeRoy in view of Robertson) fails to disclose claim limitation(s) found in each of the independent claims of the present invention. An analysis of that argument follows.

The present invention claims a method and system "for shopping in a physical retailer and online." Claim 1. The invention uses a "handheld data entry unit including an internal memory" which allows users to scan items in a physical retailer and a database that "stores item information corresponding to items scanned in the physical retailer in the internal memory of the data entry unit". Claim 1. One important aspect of the invention involves, "creating a wish list that includes the items; storing the wish list on the database; providing a web site that allows a user to generate one or more buy [or event] lists. Each buy or event lists includes "one or more of the items from the wish list." Claim 1. Applicants submit that the functionality of "[allowing] a user to generate one or more buy [or event] lists, each buy list including one or more items from the wish list" is non-obvious with respect to the prior art.

Dealing specifically with the combination cited by the Examiner, it does not teach "[allowing] a user to generate one or more buy [or event] lists, each buy list including one or more items from the wish list". LeRoy discloses a system for creating a gift registry. LeRoy does not disclose a method or system for creating individual buy lists or event lists by selecting

some subset of the items in the gift registry. Robertson discloses a system and method for creating a wish list. However, the Robertson wish list is not equivalent to the wish list of the present invention. In particular, Robertson does not disclose a method or system that would allow a user to create individual buy lists or event lists by selecting some subset of the items in the wish lists. Thus, even if the two references are combined, they fail to show the feature of selecting multiple buy or event lists from a wish list.

The difference between a wish list and a buy or event list, as well as the methods for generating each, is expressly articulated in each of the independent claims of the application. Beginning with Claim 1, each of the independent claims contains specific claim limitations regarding the relevant differences between wish lists and buy or event lists. In Claim 1, the relevant portion of a method for shopping in a physical retailer and online includes:

- creating a wish list that includes the items;
- storing the wish list on the database;
- providing a website that allows a user to generate one or more buy lists, each buy list including one or more of the items from the wish list; and transmitting a message to a buyer in order to inform the buyer of the existence of one or more of the buy lists.

Each of the remaining independent claims contain similar limitations regarding wish lists and buy/event lists. In Claim 12, the relevant portion of a computer system for shopping in a physical retailer and online includes a processor programmed to do several things including:

- create a wish list that includes items corresponding to the item information downloaded to the database;
- provide a web site that is in communication with the database, the web site allowing a user to generate one or more event lists, each event list including one or more of the items from the wish list;
- allow the user to create an access mechanism that identifies a list of buyers that are allowed to access one or more of the event lists; and
- transmit a message to one of the listed buyers in order to inform the listed buyer of the existence of one or more of the event lists.

In Claim 21, the relevant portion of a computer server for hosting a system for shopping in a physical retailer and online includes a processor, which, among other things, is programmed to:

- create a wish list from the data downloaded to the database, the wish list including the one or more items;
- provide a web site that is in communication with the database, the web site allowing a user to generate one or more buy lists, each buy list including one or more of the one or more items from the wish list; and
- transmit a message to a buyer in order to inform the buyer of the existence of one or more of the buy lists.

In Claim 28, the relevant steps of a method of receiving and communicating a list of one or more items over the Internet include:

- creating a wish list from the data downloaded to the database, the wish list including one or more of the items;
- providing a web site that is in communication with the database, the web site allowing a user to generate one or more event lists, each event list including one or more of the items from the wish list;
- allowing the user to create an access mechanism that identifies a list of users that are allowed to access one or more of the event lists; and
- transmitting a message to at least one of the listed users in order to inform the listed user of the existence of one or more of the event lists.

In Claim 30, the relevant steps of an Internet based method of receiving and communicating a list of one or more items over the Internet include:

- providing a web site having a user interface including one or more user windows, the one or more windows providing an event list screen and a wish list screen;
- retrieving a list of one or more items;
- arranging the one or more items into one or more wish lists on the wish list screen;
- entering one or more events into an event list on the event list screen; assigning one or more of the items from the wish list to one or more of the event lists;
- creating an access mechanism that identifies a list of buyers that are allowed to access one or more of the event lists; and
- transmitting a message to at least one of the listed buyers in order to inform the listed buyer of the existence of one or more of the event lists.

In Claim 33, a computer system for shopping in a physical retailer and online is programmed to do several things, which include:

- create a wish list from the data downloaded to the database, the wish list including the one or more items;

- provide a web site that is in communication with the database, the web site allowing a user to generate one or more event lists, each event list including one or more of the one or more items from the wish list; and

- connect the user with an online retailer in order to add items to one or more of the event lists.

In Claim 38, a computer system for shopping in a physical retailer and online is programmed to do several things, which include:

- download data representing one or more items from a handheld data entry unit to a database;

- create a wish list from the data downloaded to the database, the wish list including the one or more items;

- provide a web site that is in communication with the database, the web site allowing a user to generate one or more buy lists, each buy list including one or more of the one or more items from the wish list; and

- transmit a message to a concierge service to buy the items on one or more of the buy lists.

In Claim 43, the relevant portion of a computer system for shopping in a physical retailer and online, includes a processor, which, among other things, is programmed to:

- allow a user to create a wish list including one or more items by shopping at one or more electronic retailers;

- store the wish list on the database;

- provide a web site that is in communication with the database, the web site allowing a user to generate one or more buy lists which include one or more of the items from the wish list; and

- transmit a message to a buyer in order to inform the buyer of the existence of one or more of the buy lists.

The logical interpretation of the independent claims, as shown above, is that a wish list of the present invention is the set of all items that are selected by a user. Buy lists and event lists are subsets of wish lists. This interpretation of the claim language is consistent with the

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Summary of Invention and Detailed Description, which both make clear that event and buy lists are subsets of wish lists. For example, dealing particularly with event lists, Summary of Invention states:

These selected products are then stored as a "wish list" in a database coupled to the web site portal. Having selected products from the physical store or mall, the user thereafter logs into the web site portal using, for example, a personal computer and generates one or more "event lists," which include one or more products from the wish list. An event list includes a list of occasions or special dates (such as birthdays, anniversaries, trips, etc.) associated with a particular user. The user may then add products to the event list (or the wish list) from a variety of Electronic Retailers. Summary of Invention, Paragraph 2.

The Detailed Description of the invention also clearly establishes that wish lists and buy/event lists are functionally and structurally distinct. Dealing specifically with event lists, the Detailed Description states:

After the user has selected one or more products through the in-store/in-mall systems 14 and/or through the Electronic Retailers 24, a wish list 44B of products is created and stored in the central database 38. The wish list 44B contains all of the products (either located in the physical stores 22 or at the Electronic Retailers 24) that the user has shopped for and selected so that someone else (e.g., a buyer) can purchase one or more of those selected products as a gift (or for any other reason) for the user. Having generated a wish list 44B, the user can then use the web site 30 to create one or more "events" including one or more "event lists." An event is an occasion, special date, or other categorization associated with the particular user that includes one or more of the items on that user's wish list. Detailed Description, Paragraph 5.

Applicants submit that the independent claims establish that event/buy lists contain items individually selected from a wish list. Applicants further submit that this interpretation of the claim language is clearly consistent with, and moreover required by, the specification language of the application. The system and method claimed specifically allows users of the present invention to selectively choose which items from a wish list they wish to include in a buy list or event list. This functionality is established in the independent claims and disclosed in the specification. Referring specifically to event lists, the Detailed Description states:

For example, a user may have 30-40 products listed on his/her wish list, and may have several "events" up-coming, such as a ski trip, Christmas and a birthday. Using the event feature of the present invention, the user can create a "Ski Trip

Event", a "Birthday Event", and a "Christmas Event", and then select certain of the items from the wish list 44B for one or more "event lists" 44C that are linked to one of the created events. So, for example, the user may select a new jacket and pair of skis to add to the Ski Trip Event, and may select a digital camera and a tripod to add to the Birthday Event. In this manner, users can create a series of "events" in their life and then associate certain wish list items with those events. Detailed Description, Paragraph 6.

LeRoy and Robertson each fail to disclose a method or system for allowing the creation of buy/event lists which are subsets of a wish list. Applicants submit that LeRoy and Robertson taken either individually or in combination, do not teach Applicants' claimed invention. In the Office Action, the Examiner does generally address wish lists and buy/event lists, but erroneously concludes that buy and event lists are equivalent to wish lists. The Examiner states, "[t]he mere act of exposing the wish list to others via the gift registry system converts the wish list into a buy list from the perspective of others viewing the information who want to use the list to buy one or more items for the registrant" (3/1/2004 Office Action, Page 3, Paragraph 5). The Examiner's interpretation is unreasonable in that it fails to acknowledge the aspect of the present invention which, "allows a user to generate one or more buy [or event] lists, each buy list including one or more items from the wish list". Consequently, the Examiner fails to make out a *prima facie* case for obviousness. Therefore, Applicants' invention is not rendered obvious over LeRoy in view of Robertson.

Responsive to the Examiner's obviousness rejections of Claims 2, 3, 6, 7-11, 14-17, 19, 20, 22, 23, 25-27, 29, 31, 32, 34-37, 39-41, 42, and 44-46 based upon the LeRoy and Robertson references, Claims 3, 6, 7, 8, 9, 10, and 11 are dependent upon independent Claims 1, 12, 21, 28, 39, 33, 38, and 43, either directly or indirectly, and are therefore allowable for the reasons stated above for the independent claims.

- 2. Rejection of Claims 4-5, 18, and 24 as being unpatentable over LeRoy and Robertson, as applied to Claims 1, 3, 12, 22, further in view of Official Notice (regarding access control lists).**

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Responsive to the Examiner's obviousness rejections under 35 U.S.C. §103(a) of Claims 4-5, 18, and 24 based upon the LeRoy and Robertson references in view of Official Notice, Claims 4-5 are dependent upon Claim 1, either directly or indirectly, and are therefore allowable for the reasons stated above for Claim 1. Claim 18 is dependent upon Claim 12, either directly or indirectly, and is therefore allowable for the reasons stated above for Claim 12. Claim 24 is dependent upon Claim 21, either directly or indirectly, and is therefore allowable for the reasons stated above for Claim 21. Additionally, the Official Notice reference does not add any teaching to the LeRoy and Robertson combination that would contribute to an obviousness rejection of independent Claim 12.

3. Rejection of Claim 13 as being unpatentable over LeRoy and Robertson, as applied to Claim 12, further in view of Kraemer.

Responsive to the Examiner's obviousness rejections under 35 U.S.C. §103(a) of Claim 13 based upon the LeRoy and Robertson references in view of Kraemer, Claim 13 is dependent upon Claim 12, either directly or indirectly, and is therefore allowable for the reasons stated above for Claim 12. Additionally, the Kraemer reference does not add any teaching to the LeRoy and Robertson combination that would contribute to an obviousness rejection of independent Claim 12.

4. Addition of new Claims 47 through 68.

Dependant Claims 47 through 68 have been added to set forth the handheld data entry unit of the corresponding independent claim being able to retrieve, display, and edit wish lists, buy lists and event lists. Additionally, the claims set forth the possibility of the handheld data entry unit being in wireless (radio frequency) communication with the database (or processor) of the corresponding independent claim.

Applicants submit that the specification sufficiently supports the additional claims. Specifically, in the detailed description:

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In one embodiment, the system then downloads all of the user's existing wish lists, scan lists and shopping cart lists from an external database to the internal memory of the PDA (block 966) via a wireless data connection, an interface cradle, etc. In another embodiment, the system downloads information to display all of the user's existing wish lists, scan lists and shopping cart lists from an external database to the PDA via an interface cradle, a wire connection, an Infra-Red connection, etc. Detailed Description (Covington Application, Page 47, Line 7)

CONCLUSION

Reconsideration of the present application in view of the forgoing arguments is requested. It is believed that the application is in condition for allowance and action toward that end is solicited.

Applicants respectfully submit that the above represents a complete response to the Office Action. Applicants respectfully submit that the application is in condition for allowance and such action is earnestly solicited.

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In the event Applicants have overlooked the need for an extension of time or payment of fee, Applicants hereby petition therefor and authorize that any charges be made to Deposit Account No. 02-0390, BAKER & DANIELS.

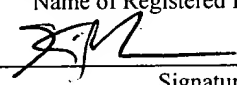
Respectfully Submitted,

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